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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/821,344	03/29/2001	Junichi Ito	OOCL-55 (6HS-01S0104)	5341
26479	7590	09/06/2005	EXAMINER	
STRAUB & POKOTYLO 620 TINTON AVENUE BLDG. B, 2ND FLOOR TINTON FALLS, NJ 07724			ZURITA, JAMES H	
			ART UNIT	PAPER NUMBER
			3625	

DATE MAILED: 09/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/821,344

Applicant(s)

ITO, JUNICHI

Examiner

James H. Zurita

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 May 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5 and 14-18 is/are pending in the application.
- 4a) Of the above claim(s) 14-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 14-18 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Prosecution History***

On 29 March 2001, applicant filed the instant application. Applicant claims priority to application 2000-119994, filed 20 April 2000 in Japan and application 2000-103630, filed 5 April 2000 in Japan.

On 5 October 2004, the Examiner issued an Election/Restriction Requirement.

On 8 November 2004, applicant elected claims 1-5 for examination, cancelled claims 7-10 and 13, and amended claims 1-3. Claims 6, 11-12 remained non-elected.

On 26 January 2005, the Examiner issued a non-final rejection of claims 1-5.

On 31 May 2005, applicant filed an amendment.

The present office action is a response to this amendment.

### ***Response to Amendment***

On 31 May 2005, applicant amended each of claims 1-5 and added claims 14-18. Applicant cancelled claims 6-13. Applicant amended Figs. 8 and 9.

Claims 1-5 and 14-18 are pending and will be examined. Of these, claims 14-18 are withdrawn from consideration as drawn to an invention not originally selected.

### ***Election/Restrictions***

Newly submitted claim 14 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Claim 14 is directed to a photographic camera, classified in class 348.

Claims 15-16, 17-18 are directed to 705, subclass 411.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 14-18 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Claim Objections***

The following claims are objected to because of informalities:

Applicant's amendment introduced a number of word processing errors. For example (errors are in ***bold italics***):

Claim 1 (currently amended) A post-product-receipt product specifications modifying method comprising:

- accepting, from a buyer who has received the product, specifications modifying information for use in modifying ***the a*** product on the basis of an information preparation program, including computer executable instructions and embedded on a tangible medium, made available to the buyer the product and;
- modifying ***the the*** product on the basis of said specifications modifying information accepted from the buyer.

Claim 5 (currently amended) The product specifications modifying method according to claim 2, wherein said product ***is camera***, and ...

Applicant is requested to review his amendment for similar errors.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 101***

Applicant has attempted to overcome rejection under 35 USC 101 by amending claim1 to read:

- 1 A post-product-receipt product specifications-modifying method comprising:
  - **accepting**, from a buyer who has received the product, specifications modifying information for use in modifying the a product on the basis of an information preparation

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program, including computer executable instructions and embedded on a tangible medium, made available to the buyer the product and;

- ***modifying*** the product on the basis of said specifications modifying information accepted from the buyer.

As previously explained, the technology must be actively involved in the methods steps, mere intended or nominal use of a component, albeit within the technological arts, does not confer statutory subject matter to an otherwise abstract idea if the component does not apply, involve, use, or advance the underlying process.

In the present case, the program [labeled “information preparation program”] does not appear to be actively involved in accepting input [labeled “specifications modifying information”] and does not appear to be actively involved in creating output that would be used for modification. Please note that mere application of various labels to different steps and parts is not sufficient to overcome this rejection.

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

It is noted that certain claims appear to contain limitations, that are implied and not positively recited. In addition, several of the labels appear to refer to actions that take place outside the metes and bounds of the claims.

For example, in claim 1’s preamble, applicant refers to a method that he labels “...post-product-receipt product specifications-modifying...” method that appears to limit his claims actions that take place after an implied step of receiving a product. Step

1 refers to a buyer, "...who has received the product...", that is another step that occurs outside the metes and bounds of claim 1.

Applicant refers to information "...for use in modifying a product on the basis of a ...program..." and labels the program as "...an information preparation program..." that includes, but does not actively execute "...computer executable instructions..."

The actions take place outside the metes and bounds of the claims. As noted in prior office actions and in the present rejection, the language carries little or no patentable weight.

**Claims 1-5** are rejected under 35 U.S.C. 103(a) as being unpatentable over Henson (US 6,167,383) in view of Parulski (US 6,836,617).

**As per claim 1**, Henson discloses systems and method steps for a customer to modify the specifications for an electronic product according to a customer's demand.

Henson discloses

**Accepting** from a buyer specifications modifying information for use in modifying a product on the basis of an information preparation program. The computer executable instructions are made available to a user over the Internet in HTML forms. The programs execute to accept information used by Henson to modify a product on the basis of output from the programs. For example, Fig. 4 and various configurable items that can be selected by a customer) to customize his computer. See also Fig. 1 and references to configurator program.

**Modifying** the product on the basis of information accepted from the buyer. See, for example, at least Col. 2, line 5-Col. 3, line 54, which disclose that a computer has

been modified according to information obtained from various user interfaces. The various programs are made available over the Internet to customers that buy products such as computers. The programs accept customer modifications to specifications to satisfy the customer's demands.

Henson does not specifically refer to a "...post-product-receipt product specifications..." program. Henson does not specifically refer to a buyer "...who has received the product..." However, the differences do not alter the **accepting** and **modifying** steps. As noted earlier, the language refers to actions that are outside the metes and bounds of the claims and carry little patentable weight. In addition, the labels given to various actors and modules are not functionally related to the substrate of the article of manufacture. The labels themselves carry little or no patentable weight. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to apply a label to various actors and modules in a system such as **Henson** and Parulski because such data does not functionally relate to the substrate of the article of manufacture and merely labeling the data differently from that in the prior art would have been obvious. See *Gulack* cited above.

**As per claim 2**, Henson transmitting said **info\_01** from the buyer to a supplier of the product by way of a telecommunication line wherein the specifications modifying

step is performed by the supplier. See, for example, at least Fig. 2 and references to the Internet. See also at least Col. 2, lines 36-53.

***As per claim 3***, Henson discloses **recording** and **sending** the information from a buyer to a supplier of a product. See, for example, at least Fig. 2, item 40, and Fig. 11 and related text, which describe storage devices that store prepared information. For sending the information to a supplier, see at least Fig. 2 and references to the Internet.

***As per claim 3***, Henson **does not** specifically disclose that the medium that contains the information is sent from a buyer to a supplier. Henson discloses serving various business segments, including government and corporate clients, whose personnel may login to alter limited specifications. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Henson to disclose that information may be transmitted by sending recording medium that stores information from a customer to a supplier. One of ordinary skill in the art at the time the invention was made would have been motivated to modify Henson to disclose that information may be transmitted by sending recording medium that stores information from a customer to a supplier for the obvious reason that such a feature would require a single transmission of information, as opposed to multiple transmissions by a single customer, perhaps one for each employee.

***As per claim 4***, Henson discloses **evaluating** an expense associated with the specified modification to the product. For example, see Fig. 1 and references to pricing, and references to *update price* button in Fig. 3B, and related text.



***As per claim 5***, While Henson discloses that a customer may modify the specifications for an electronic product according to a customer's demand. Henson ***does not*** specifically disclose that the information may include at least one of (a) information specifying the painting and the printing of the outer surface of the computer, (b) information specifying the modification to be made to the profile of the computer and (c) information specifying the modification to be made to an operation control program of the computer. See, for example, references to operating system, Col. 15, lines 24-30.

Henson ***does not*** disclose his invention for cameras. Parulski discloses customizing electronic products such as cameras according to a customer's demand. See, for example, at least Fig. 11 and related text.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Henson and Parulski to disclose for (a) painting and printing an outer surface of a camera, (b) profile of a camera, and (c) the operating control program of a camera.

One of ordinary skill in the art at the time the invention was made would have been motivated to combine Henson and Parulski to disclose for (a) painting and printing an outer surface of a camera, (b) profile of a camera, and (c) the operating control program of a camera for the obvious reason that mass customization of items such as cameras, permits use of mass production lines yet allow for increased sales by permitting personalization of a camera to create a unique birthday gift, for example.

See also, in Parulski, references to customizing a camera with memory cards, as Henson does for computers.

### ***Response to Arguments***

Applicant's arguments filed 31 May 2005 have been fully considered.

Objections to the drawings are withdrawn in view of amendment.

Objections to various claims are withdrawn in view of amendment.

Rejections of claims 1-5 under 35 USC 112, second paragraph are withdrawn in view of amendment.

Rejections of claims 1-5 under 35 USC 101 are maintained. See above.

Applicant's arguments concerning rejection under 35 USC 103 have been very carefully reviewed, but are not persuasive.

On page 11, line 24-page 12, line 18, applicant argues that Henson and Parulski performs various claimed actions when ordering a product, and not after the product has been purchased or received. The Examiner notes that the language on which applicant relies recites actions implied but not positively recited, that occur outside the metes and bounds of the claim and as such carry little or no patentable weight.

On page 12, line 19-page 13, line 25 appear to recite various benefits that applicant perceives in his invention to various types of customers. In response to these comments, the Examiner notes that the features upon which applicant relies are not recited in the rejected claim(s). Although the claims are interpreted in light of the

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specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

On page 14, lines 1-9, applicant purports to disagree with the Examiner's reasons for combining Henson and Parulski. Specifically,

On page 14, lines 10-17, first, applicant appears to argue that the references teach away from a proposed modification. In response to these arguments, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, please refer to page 11 of the prior office action concerning suggestions to combine.

Applicant also argues,

First, the fact that customers like to comparison shop would lead one skilled in the art to make a product specification customization program available to consumers pre-purchase (before the product is received), not post-purchase (after the product is received). Thus, the desirability of comparison shopping would lead one skilled in the art away from the modification proposed by the Examiner. Page 14, lines 10-17.

In response to this comment, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

The Examiner also notes that the terms pre-purchase and post-purchase are absent from the claim. Again, while the claims are interpreted in light of the

specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The Examiner also notes that while applicant may be his or her own lexicographer, a term may not be given a meaning repugnant to the usual meaning of that term. See *In re Hill*, 161 F.2d 367, 73 USPQ 482 (CCPA 1947). Applicant's use of various terms is misleading and inconsistent with their meaning and usage: ***pre-purchase*** as equivalent to ***before a product is received*** and ***post-purchase*** as equivalent to ***after a product is received***. To purchase is to obtain by paying money or its equivalent.<sup>1</sup> To receive is to come into possession of.<sup>2</sup> These terms are not mutually exclusive. For example, one may receive a product prior to purchase.

On page 14, lines 18-24, second. Applicant appears to argue that, for various reasons, including size and complexity, computers and cameras are non-analogous art. Again, in response to these arguments, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). Applicant's claims are directed to modifying a product. Henson and Parulski are directed to modifying a product.

The Examiner also notes that applicant appears to claim patentable distinction based upon actions that are implied but not positively recited. In addition, language such as "...post-product-receipt product specifications modifying [method]...";

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<sup>1</sup> Definition of *purchase* (vt) MERRIAM WEBSTERS Collegiate Dictionary.

"...[buyer] who has received the product..." "...for use in modifying a product..."

"specifications modifying information..." refer to activities that appear outside the metes and bounds of claim 1. As such, the language carries little or no patentable weight.

Henson and Parulski do not use applicant's various terms and their labels. However, the labels given to various actors and modules are not functionally related to the substrate of the article of manufacture. The labels themselves carry little or no patentable weight. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to apply a label to various actors and modules in a system such as Henson and Parulski because such data does not functionally relate to the substrate of the article of manufacture and merely labeling the data differently from that in the prior art would have been obvious. See *Gulack* cited above.

On page 14, lines 25-31, third, applicant argues that there is no suggestion in the prior art to combine Henson and Parulski. The Examiner respectfully disagrees, and directs applicant's attention to page 11 of the prior office action. In addition, the Examiner notes that it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time

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<sup>2</sup> Definition of *receive*, MERRIAM WEBSTERS Collegiate Dictionary.

the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

On page 15, lines 1-24, concerning claim 5, applicant appears to argue that the references disclose helping a customer to obtain a desired product ***when ordering the product, not after obtaining it.*** [emphasis in original]. Again, the Examiner notes that ordering and obtaining a product are not recited in the claims. Further, while applicant may be his or her own lexicographer, a term may not be given a meaning repugnant to the usual meaning of that term. See *In re Hill*, 161 F.2d 367, 73 USPQ 482 (CCPA 1947). Applicant's use of various terms is misleading and inconsistent with their meaning and usage. To order is to give or place an order. An order is a request to buy, sell, deliver or receive goods or services that commits the issuer of the order to the terms specified.<sup>3</sup>

On page 13, lines 26-31, applicant concludes that Henson and Parulski do not render his claims obvious. The examiner respectfully disagrees for reasons stated above.

### **Conclusion**

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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<sup>3</sup> Definition of *order*, BARRONS Dictionary of Business Terms,

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H Zurita whose telephone number is 703-605-4966. The examiner can normally be reached on 8a-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703-308-1344. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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*JZ*  
**James Zurita**  
**Patent Examiner**  
**Art Unit 3625**  
29 August 2005

  
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